

REMARKS

Claims 21-31 are pending. Claims 21 and 27 are amended. The Specification is amended to identify the parent application's U.S. Patent No. 6,616,661 and to equivalently identify the peripheral edge 106a of the slot 106 as also referred to as a hook member, thereby obviating the 35 U.S.C. 112, 1st paragraph rejections set forth in the Office Action. No new matter is submitted. Accordingly, entry and consideration of the Office Action is respectfully requested.

Withdrawal of the Specification objection cited in the Office Action is respectfully requested as the Specification has been amended to include the requested U.S. Patent No. 6,616,661, thereby obviating the Specification objection.

Withdrawal of the 35 U.S.C. 112, 1st paragraph rejections cited in the Office Action is respectfully requested as the Specification amendment at page 7, equivalently identifying the peripheral edge 106a of the slot 106 obviates the various rejections cited in the Office Action.

In the Office Action, claims 21-31 are rejected under 35 U.S.C. 102(b) as allegedly anticipated by U.S. Patent No. 5,190,541 to Abele (hereafter "Abele"). The rejection is respectfully traversed.

To maintain a 35 U.S.C. 102(b) rejection a reference must teach each and every feature of a claimed invention. Abele does not do so.

Applicants' claim 1 recites a surgical device comprising, inter alia, a tubular shaft, a slot comprising a cross-sectional portion of the tubular shaft and at a distal end thereof, a hook member in communication with the slot, a clamp slidably disposed in the slot and having a clamping surface at a distal end to capture tissue between the hook member and the clamping surface, and at least one electrode for applying RF energy to the tissue captured in the slot.

Applicants' claim 27 recites a surgical device comprising, inter alia, a tubular shaft, a slot comprising a cross-sectional portion of the tubular shaft and at a distal end thereof, a hook member in communication with the slot, the hook member having at least one electrode for applying RF energy to tissue captured in the slot, and a clamp slidingly disposed at a distal end to capture the tissue in the slot between the hook member and the clamping surface.

Abele discloses a laparoscopic instrument 10 having a shaft 12 with a J-hook member 16 at its distal end. The J-hook member 16 is formed by leg 40 that extends beyond the shaft 12, a cross-member 42 that extends from the leg 40 to form a ledge 62, and a tip 44 that returns proximally from the cross-member 42 (col. 4, lines 9-24 & Fig. 2). Thus, the J-hook member 16 of Abele is not a cross-sectional portion of a tubular shaft as recited in independent claims 21 and 27 of Applicants' invention, from which all other claims depend. Accordingly, withdrawal of the 35 U.S.C. 102(b) rejection of claims 21-31 based on Abele is respectfully requested.

In the Office Action, claims 21-23, 27 and 28 are rejected under 35 U.S.C. 102(b) as allegedly anticipated by U.S. Patent No. 5,366,476 to Noda (hereafter "Noda"). The rejection is respectfully traversed.

As before, to maintain a 35 U.S.C. 102(b) rejection, a reference must teach each and every feature of a claim. Noda does not do so.

Applicants' invention with respect to independent claims 21 and 27 is discussed above. Claims 22 and 23 depend directly or indirectly from claim 21, whereas claim 28 depends from claim 27.

Noda discloses an electrosurgical device having a shaft 36 comprised of electrically conductive tubing 106 having a proximal end 38 and a distal end 40. A hook 42 is separately

secured to the distal end 40 of the shaft 36 (col. 7, lines 4-5). Thus, Noda fails to disclose a slot comprising a cross-sectional portion of a tubular shaft as recited in independent claims 21 and 27 of Applicants' invention. Accordingly, withdrawal of the 35 U.S.C. 102(b) rejection of claims 21-23, 27 and 28 based on Noda is respectfully requested.

In the Office Action, claims 21-31 are rejected under 35 U.S.C. 103(a) as allegedly unpatentable over U.S. Patent No. 6,224,593 to Ryan (hereafter "Ryan") in view of Abele. The rejection is respectfully traversed.

Applicants' invention with respect to independent claims 21 and 27 is discussed above. Likewise, Abele is discussed above.

Ryan discloses a microwave instrument 12 including an elongate member or chassis 18, an extension 32 comprised of a longitudinal portion 34 extending from a distal end of the elongate member or chassis 18, and a tissue capturing portion 36 extending generally transverse to the longitudinal portion 34 of the extension 32 at the distal end thereof. Ryan thus fails to disclose or suggest a tubular shaft having a slot comprised of a cross-sectional portion of the tubular shaft in which slot tissue is captured as recited in each of independent claims 21 and 27 of Applicants' invention. Abele is deficient for similar reasons as discussed above. Thus, neither Ryan nor Abele single, nor in combination, teach, disclose or suggest the combination of features recited in claims 21 and 27 of Applicants' invention, from which all other claims depend. Accordingly, withdrawal of the 35 U.S.C. 103(a) rejection of claims 21-31 based on the combination of Ryan and Abele is respectfully requested.

Finally, in the Office Action, claims 24-26 and 29-31 are rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Noda in view of Abele. The rejection is respectfully traversed.

Applicants' invention with respect to independent claims 21 and 27, from which claims 24-26 and 29-31 respectively directly or indirectly depend, is discussed above. Likewise, Noda and Abele are discussed above. Neither Noda nor Abele teach, disclose or suggest the aspect of the tubular shaft having a slot comprised of a cross-sectional portion of the tubular shaft in which tissue is captured as recited in claims 21 and 27 of Applicants' invention. Moreover, as conceded in the Office Action, Noda further fails to disclose a clamping member and a cutting member. For at least the reasons discussed herein, neither Noda nor Abele singly, or in combination, teach, disclose or suggest the combination of features recited in independent claims 21 and 27, from which claims 24-26 and 29-31 respectively depend. Accordingly, withdrawal of the 35 U.S.C. 103(a) rejection of claims 24-26 and 29-31 based on the combination of Noda and Abele is respectfully requested.

Applicants submit, in view of the amendments and Remarks made herein, that the claims patentably distinguish over the art applied and pose no 35 U.S.C. 112 issues. Accordingly, prompt examination and allowance of claims 21-31 is respectfully solicited.

Should the Examiner determine that anything further is desirable to place this application in even better form for Allowance, the Examiner is invited to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

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